UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/720,885 | 04/02/2001 | Marie Bern | 15292.3 | 5867 |

22913 7590 03/09/2006

WORKMAN NYDEGGER
(F/K/A WORKMAN NYDEGGER & SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

| EXAMINER | |
|---|---|
| LAZARO, DAVID R | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2155 | |

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/720,885 | BERN, MARIE | |
| | Examiner | Art Unit | |
| | David Lazaro | 2155 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *21 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,4-9,11-13,15 and 16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-9,11-13,15 and 16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This office action is in response to the RCE filed 12/21/2005.

2. Claims 1 and 9 were amended.

3. Claims 2, 3, 10 and 14 are canceled.

4. Claims 15 and 16 are newly added.

5. Claims 1, 4-9, 11-13, 15 and 16 are pending in this office action.

### *Response to Amendment/Arguments*

6. Applicant's arguments with respect to claims 1, 4-9, 11-13, 15 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments concerning claim 16 are not persuasive. Particularly, Applicant states, "*The embodiment recited in claim 16 is also contrasted with embodiments in Tso, which specifies how InfoBites are generated irrespective of user relevance, and that the InfoBites are filtered, only after being generated, to decide which InfoBites pertain to a particular user.*"

8. It is important to note that the claim language states "wherein the message is generated"(emphasis added). Taken by themselves, the InfoBites of Tso are not the "message". An InfoBite becomes a part of the message when it is sent to the user. As such, the generation of an InfoBite itself is not of relevance to the particular claim language of Claim 16. What is of relevance is the generation of the message that contains the Infobite. Col. 13, line 59 to Col. 14, line 19, discloses that a message containing the InfoBite is generated upon determining that the information related to the

InfoBite is of relevance to the user that the message is being sent to. The examiner considers this to be within the scope of the claimed subject matter.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,047,327 by Tso et al. (Tso) in view of U.S. Patent 5,895,471 by King et al. (King) and U.S. Patent Application 2001/0032254 by Hawkins (Hawkins).

11. With respect to Claim 1, Tso teaches a method for accessing information stored at an information server (Col. 5 lines 31-53) and being retrievable using the Internet (Col. 2 lines 1-6), the location of said information being specified by address data stored at an address server which is connected to the Internet (Col. 6 lines 5-20), the address data being associated with an identifier in said address server (Col. 6 lines 5-10), the method comprising the acts of:

transmitting said identifier in a message from said address server to a mobile station (Col. 8 lines 48-53) using a short message based service provided in a mobile communication network (Col. 11 lines 19-26);

retrieving, at said mobile station, said identifier from said message (Col. 8 lines 48-58) and relaying the identifier to means for accessing the Internet associated with the mobile station (Col. 15 lines 19-27);

accessing said address server from said means for accessing the Internet, using an Internet protocol over a data communication bearer service provided to said mobile station by said mobile communication network (Col. 15 lines 19-27), by transmitting a URL designating said address Server (The examiner notes a URL would be used to access a resource, such as the address server, on the internet as in Col. 15 lines 19-27 and Col. 24 lines 43-54);

selecting said information with said means for accessing the internet by using said identifier when accessing the address server (Col. 8 lines 48-60); and

providing said information, identified by the address data associated with the identifier, to said mobile station using an Internet protocol over said data communication bearer service , by using said address data associated with the identifier at said address server to access said information (Col. 8 lines 58-64 and Col. 24 lines 60-66). Tso further teaches information provided by the information server can be provided from a content database to said mobile station via the address server (Col. 5 lines 31-53; Col. 8 lines 47-57; Col. 24 lines 60-66).

Tso does not explicitly disclose using the identifier as an argument to a URL designating the address server when accessing the address server. King teaches a bookmark server that is analogous to an address, in that it stores address data for information stored at information servers (Col. 11 lines 41-65). To access address data,

an identifier associated with the address data is used as an argument in a URL designating the address server (Col. 12 lines 5-16).

Tso also does not disclose that the information server is explicitly accessed in response to said mobile station accessing said address server. Hawkings teaches a proxy server that accesses an information server in response to being accessed by a mobile station such that the information is provided from the information server to the mobile station via the proxy server (Pages 5-6 [0085] and [0093]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Tso and modify it as indicated by King and Hawkins such that the method further comprises selecting said information with said means for accessing the internet by using said identifier as an argument to said URL which designates said address server when accessing the address server; and providing said information, identified by the address data associated with the identifier, to said mobile station using an Internet protocol over said data communication bearer service, by using said address data associated with the identifier at said address server to access said information server over the internet in response to said mobile station access said address server, said information being provided from said information server to said mobile station via said address server. One would be motivated to incorporate the teachings of King and Hawkins, as it is desirable to improve the way resource limited mobile devices access Internet information over relatively low bandwidth networks (In King: Col. 11 lines 32-45; and In Hawkings: Page 2 [0018] and Pages 3-4 [0047]).

12. With respect to Claim 4, Tso does not explicitly disclose wherein said accessing act comprises attaching said identifier as an argument to a mobile station prestored URL designating said address server. King teaches attaching an identifier as an argument to a mobile station prestored URL designating said address server (In King: Col. 11, lines 40-45, the bookmark server URL is sent to remote device during initialization of the device. This is interpreted as being within the scope of a "prestored URL designating said address server".).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Tso and modify it as indicated by King such that wherein said accessing act comprises attaching said identifier as an argument to a mobile station prestored URL designating said address server. One would be motivated to incorporate the teachings of King and Hawkins, as it is desirable to improve the way resource limited mobile devices access Internet information (In King: Col. 11 lines 32-45).

13. With respect to Claim 5, Tso further teaches monitoring, at said address server, said information at said information server (Col. 13 lines 35-58 of Tso); and performing said act of transmitting said identifier to said mobile station for notifying mobile station of a change in said information at said information server (Col. 13 lines 59-64 of Tso).

14. With respect to Claim 6, Tso further teaches wherein said monitoring act comprises accepting push data transfers from said information server storing said information (Col. 6 line 64 - Col. 7 line 9 of Tso).

15. With respect to Claim 7, Tso further teaches wherein said communication network is a GSM network and said message based service is a mobile data service provided by said GSM network (Col. 3 line 49 - Col. 4 line 3 of Tso).

16. With respect to Claim 8, Tso further teaches wherein said mobile data service is either SMS or USSD service (Col. 3 lines 49-54 of Tso).

17. With respect to Claim 9, Tso teaches an arrangement at a server for providing access to information stored at an information server (Col. 5 lines 31-53) and being retrievable using the Internet (Col. 2 lines 1-6), the arrangement comprising:

means for storing address data specifying the location of said information and for storing an identifier which is associated with said address data (Col. 6 lines 5-20);

means for transmitting said identifier in a message to a mobile station using a short message based service provided by a mobile communication network (Col. 11 lines 20-27), and

access means for, during an Internet session with said mobile station (Col. 15 lines 19-27), receiving said identifier transmitted from the mobile station and deriving the address data associated with said identifier (Col. 8 lines 48-53), wherein said derived address data identifies said information which should be transferred to said mobile station (Col. 8 lines 48-57 and Col. 24 lines 60-66); and

means for providing said information identified with said derived address data to said mobile station (Col. 8 lines 48-57 and Col. 24 lines 60-66), the means comprising:

using said derived address data to access said information in response to receiving said identifier from said mobile station (Col. 8 lines 58-64 and Col. 24 lines 60-66).

transferring information accessed from said information server to said mobile station using an Internet protocol over a data communication bearer server provided by said mobile communication network (Col. 5 lines 31-53; Col. 8 lines 47-57; Col. 15 lines 18-27; Col. 24 lines 60-66).

Tso does not explicitly disclose the server receiving the identifier as an argument to a URL designating the address server. King teaches a bookmark server that is analogous to an address, in that it stores address data for information stored at information servers (Col. 11 lines 41-65). To access address data, an identifier associated with the address data is used as an argument in a URL designating the address server (Col. 12 lines 5-16).

Tso also does not disclose that the information server is explicitly accessed over the internet in response to receiving the identifier. Hawkings teaches a proxy server that accesses an information server in response to being accessed by a mobile station such that the information is provided from the information server to the mobile station via the proxy server (Pages 5-6 [0085] and [0093]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the arrangement disclosed by Tso and modify it as indicated by King and Hawkins such that the method further comprises receiving said identifier as an argument in a URL which designates said address server transmitted

from the mobile station and deriving the address data associated with said identifier; and using said derived address data to access said information at said information server over the internet in response to receiving said identifier from said mobile station; and transferring said information accessed at said information server to said mobile station using an Internet protocol over a data communication bearer service provided by said mobile communication network. One would be motivated to incorporate the teachings of King and Hawkins, as it is desirable to improve the way resource limited mobile devices access Internet information over relatively low bandwidth networks (In King: Col. 11 lines 32-45; and In Hawkings: Page 2 [0018] and Pages 3-4 [0047]).

18. With respect to Claim 11, Tso further teaches wherein said access means are arranged to: transfer said derived address data to said mobile station (Col. 25 lines 20-24 of Tso).

19. With respect to Claim 12, Tso teaches an arrangement at a mobile station (Col. 4 lines 54-64) for accessing information stored (Col. 5 lines 31-53) at an information server and being retrievable using the Internet (Col. 2 lines 1-6), the arrangement comprising;

means for receiving from an address server an identifier (Col. 8 lines 48-58) being transferred in a message of a short message based service provided by a mobile communication network (Col. 11 lines 20-27 and Col. 3 lines 49-55); and

access means for accessing said address server by means of a URL (The examiner notes a URL would be used to access a resource, such as the address server, on the internet as in Col. 15 lines 19-27 and Col. 24 lines 43-54)and transmitting

the received identifier to the address server using an Internet protocol over a data communication bearer service provided by the mobile communication network Col. 8 lines 47-57; Col. 15 lines 18-27, and for receiving said information from said address server over said Internet protocol and said data communication bearer service (Col. 8 lines 47-57 and Col. 24 lines 60-66), said information having been retrieved by the address server from the information server over the internet (Col. 5 lines 31-53; Col. 8 lines 47-57).

Tso does not explicitly disclose attaching said received identifier as an argument to a URL designating the address server when accessing the address server. King teaches a bookmark server that is analogous to an address, in that it stores address data for information stored at information servers (Col. 11 lines 41-65). To access address data, an identifier associated with the address data is used as an argument in a URL designating the address server (Col. 12 lines 5-16).

Tso also does not disclose explicitly retrieving information from the information server in response to the address server being accessed by the mobile station. Hawkings teaches a proxy server that accesses an information server in response to being accessed by a mobile station such that the information is provided from the information server to the mobile station via the proxy server (Pages 5-6 [0085] and [0093]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the arrangement disclosed by Tso and modify it as indicated by Hawkins such that the arrangement further comprises access means for

attaching said received identifier as an argument in a URL designating said address server, accessing said address server, by means of the URL using an Internet protocol over a data communication bearer server provided by the mobile communication network, and for receiving said information from said address server over said internet protocol and said data communication bearer server, said said information having been retrieved by the address server from the information server over the internet in response to the address server being accessed by the mobile station. One would be motivated to incorporate the teachings of King and Hawkins, as it is desirable to improve the way resource limited mobile devices access Internet information over relatively low bandwidth networks (In King: Col. 11 lines 32-45; and In Hawkings: Page 2 [0018] and Pages 3-4 [0047]).

20. With respect to Claim 13, Tso does not explicitly disclose wherein said access means are provided to attach said identifier as an argument to a mobile station prestored URL designating said address server. King teaches attaching an identifier as an argument to a mobile station prestored URL designating said address server (In King: Col. 11, lines 40-45, the bookmark server URL is sent to remote device during initialization of the device. This is interpreted as being within the scope of a "prestored URL designating said address server".).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Tso and modify it as indicated by King such that wherein said access means are provided to attach said identifier as an argument to a mobile station prestored URL designating said address server. One

would be motivated to incorporate the teachings of King and Hawkins, as it is desirable to improve the way resource limited mobile devices access Internet information (In King: Col. 11 lines 32-45).

21. With respect to Claim 14, Tso does not explicitly disclose wherein the URL designating the address server is prestored, and wherein, upon retrieving the identifier, the mobile station automatically attaches the identifier to the prestored URL. King teaches the URL designating the address server is prestored and that an identifier is automatically attached as an argument to the prestored URL designating said address server (In King: Col. 11, lines 40-45, the bookmark server URL is sent to remote device during initialization of the device. This is interpreted as being within the scope of a "prestored URL designating said address server".).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Tso and modify it as indicated by King such that wherein the URL designating the address server is prestored, and wherein, upon retrieving the identifier, the mobile station automatically attaches the identifier to the prestored URL. One would be motivated to incorporate the teachings of King and Hawkins, as it is desirable to improve the way resource limited mobile devices access Internet information (In King: Col. 11 lines 32-45).

22. With respect to Claim 16, Tso further teaches the address server monitoring a predefined information location for information that is determined to be of relevance to a user, and wherein the message is generated by the address server upon identifying the

information that is determined to be of relevance to the user (In Tso: Col. 13 line 59 - Col. 14 line 19).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Lazaro
March 3, 2006

SALEH NAJJAR
SUPERVISORY PATENT EXAMINER